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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,634	03/01/2002	Henry Yue	PF-0738 USN	9443

7590 02/17/2004

Incyte Genomics Inc
Legal Department
3160 Porter Drive
Palo Alto, CA 94304

EXAMINER

PATTERSON, CHARLES L JR

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,634

Applicant(s)

YUE ET AL.

Examiner

Charles L. Patterson, Jr.

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1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups 1-13, claims 1-2, 16-17, 19-20, 22-23, 25-26, drawn to a polypeptide of SEQ ID NO:2-14, a composition comprising the polypeptide, a method for screening a compound for effectiveness as an agonist or antagonist of the polypeptide, a composition comprising the agonist or antagonist, a method of screening a compound for binding or modulation of activity of the polypeptide. The group number correspond to the sequence number.

Groups 14-26, claims 3-7, 9, 11-15, 27, drawn to a polynucleotide of SEQ ID NO:16-28, a host cell, a method for producing a polypeptide using the polynucleotide, a method for detecting the polynucleotide by using a probe or by amplifying the polynucleotide, a method for screening a compound for effectiveness in altering the expression of the polynucleotide. The group number correspond to the sequence number.

Groups 27-39, claim 8, drawn to a transgenic organism comprising SEQ ID NO:16-28. The group number correspond to the sequence number.

Groups 40-52, claim 10, drawn to an antibody that binds to SEQ ID NO:2-14. The group number correspond to the sequence number.

Groups 53-65, claims 18, 21, drawn to a method for treating a disease associated with decreased expression of HYENZ, comprising administering SEQ ID NO:2-14. The group number correspond to the sequence number.

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Groups 66-78, claim 24, drawn to a method for treating a disease associated with overexpression of HYENZ, comprising administering SEQ ID NO:2-14. The group number correspond to the sequence number.

Groups 79-91, claim 28, drawn to a method for assessing toxicity of a test compound comprising treating a sample containing nucleic acids with a test compound and hybridizing the nucleic acids with a probe of at least 20 nucleotide of SEQ ID NO:16-28. The group number correspond to the sequence number.

The inventions listed as Groups 1-91 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The polypeptides of Groups 1-13 are not a special technical feature of the polynucleotides of Groups 14-26 because the Acc No. 015416, cited in the PCT search report, discloses Groups 14-26. The transgenic organisms of Groups 27-39 are an additional host from the host cells of Groups 14-26. The use of the polypeptides of Groups 1-13 to produce the antibodies of Groups 40-52 is an addition use from the 4 uses as for screening in Groups 1-13. The methods of treatment of Groups 53-78 are additional uses for Groups 1-13 and Groups 53-65 are different uses that Groups 66-78 because one is involved with a disease the has decreased expression of HYENZ while that other has overexpression. The method of Groups 79-91 is an additional use of the polynucleotides of Groups 14-26 than the 3 methods in Groups 14-26.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

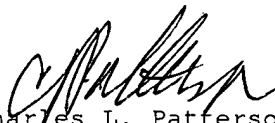
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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 571-272-0936. The examiner can normally be reached on Monday - Friday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4242.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
February 11, 2004